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Atty. Dkt. No. TVG/4885-5

**REMARKS**

This is intended as a full and complete response to the final Office Action mailed on March 24, 2004. Please reconsider the claims pending in the application for reasons discussed below.

Claims 1 - 15 remain pending in the application, are shown above, and stand rejected. Reconsideration of those claims is requested for the reasons presented below.

The secondary references made of record are noted. However, it is believed that the secondary references are no more pertinent to the Applicants' disclosure than the primary references cited in the office action. Therefore, Applicants believes that a detailed discussion of the secondary references is not necessary for a full and complete response to this office action.

**Rejections of Claims 1, 3, 5, 7-9, 11-12 and 14-15 Under 35 U.S.C. §102(e)**

The Examiner has rejected claims 1, 3, 5, 7-9, 11-12 and 14-15 under 35 U.S.C. §102(e) as being anticipated by Fries (U.S. Patent 6,317,885, hereinafter "Fries"). With all respect to the Examiner, that rejection is respectfully traversed.

"Anticipation requires the presence in a single prior art reference disclosure of each and every element of the claimed invention, arranged as in the claim" (Lindemann Maschinenfabrik GmbH v. American Hoist & Derrick Co., 730 F.2d 1452, 221 U.S.P.Q. 481, 485 (Fed. Cir. 1984)(citing Connell v. Sears, Roebuck & Co., 722 F.2d 1542, 220 U.S.P.Q. 193 (Fed. Cir. 1983)) (emphasis added). Fries fails to disclose each and every element of the claimed invention, as arranged in the claim.

Fries teaches an interactive entertainment and information system that makes use of television set-top boxes. Pages of interactive information are periodically sent to the set-top boxes. Those pages include meta-data that define active locations on each page. When a page is displayed, user interaction by a remote control causes the system to read the meta-data and to take an appropriate action such as moving to other active locations, hyperlinking to other pages, entering user form data, and submitting the data as a form into memory. Pages may be related to a conventional television program, thereby providing significant user interactivity with the television.

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In contrast, the subject invention relates to using a broadcast advertisement to interact with local presentation software to provide a program guide with features provided for in the advertisement.

For convenience, the independent claims are provided below (the other independent claims are related):

"1. A method for allowing access to interactive features of an electronic program guide by a user from within a broadcast advertisement, the method comprising:

storing presentation guide software for presenting an electronic program guide at a user location;

receiving a broadcast advertisement comprising audio, video and promotional metadata over a broadcast distribution network;

analyzing the promotional metadata to determine one or more valid electronic program guide features;

displaying an electronic program guide;

presenting the one or more valid electronic program guide features within the electronic program guide; and

executing an electronic program guide feature selected by the user." [Emphasis added].

"14. Computer readable media comprising program code, the program code operative to be executed by a programmable computer, the program code comprising a method for allowing access to interactive features of an electronic program guide by a user from within a broadcast advertisement, the method comprising:

storing presentation guide software for presenting an electronic program guide at a user location;

receiving the broadcast advertisement comprising audio, video and promotional metadata over a broadcast distribution network;

displaying the electronic program guide on a display device;

analyzing the promotional metadata to determine one or more electronic program guide features;

presenting one or more electronic program guide features within the electronic program guide; and

executing an electronic program guide feature." [Emphasis added].

"15. A system for allowing access to interactive features of an electronic program guide from within a broadcast advertisement, the system comprising:

promotional metadata comprising information regarding an advertisement and one or more valid electronic program guide features that may be accessed from within the advertisement and that are

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associated with the promotional metadata information;  
presentation software operative to form an electronic program guide on a display, wherein said electronic program guide can include said one or more electronic program guide features and wherein the presentation software enables a user to use the electronic program guide to link to the advertisement." [Emphasis added].

Independent claims 1, 14, and 15 are directed to methods, computer readable media, and systems wherein a broadcast advertisement provides interactive features that are shown in an electronic program guide that is produced using local (to the user) presentation software. The broadcast advertisement includes promotional metadata that is analyzed to determine one or more valid electronic program guide features. Those features are then shown by the presentation software within an electronic program guide for selection by a user.

By contrast, Fries fails to teach or suggest using a broadcast advertisement to convey information that is used by local presentation software to provide input to an electronic program guide. Fries uses a channel reserved for an information service to send pages that are displayed. To change the display to provide new information a new page is sent. In contrast, the subject invention uses broadcast advertisements that interact with local software to produce an electronic program guide that locates metadata from the advertisement in the electronic program guide.

Fries does discuss using a browser that has been downloaded into a set-top box, see column 6, lines 37-40, and also discusses that the browser interacts with the pages that have been converted into an "intermediate format," see column 6, lines 48-52. One reason that Fries uses an intermediate format is to "reduce the amount of processing that needs to be performed by the processor 74 at the cable end [which is in the set-top box]," see column 20, lines 24-27. In direct contrast, the subject invention uses local presentation software to show a broadcast advertisement which is not modified into an intermediate format, albeit the advertisement includes metadata. In the subject invention the processing load rests squarely on the local processor to format the electronic program guide. Thus, in Fries there is no, "analyzing the promotional metadata ..." as recited in claims 1 and 14.

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The dependent claims 3, 5, 7-9, and 11-12 of the present application contain additional features that further distinguish the present invention over the prior art of record. Since those claims depend from allowable base claim 1, those claims are also allowable. However, claim 5 is amended for clarity.

In view of the foregoing, withdrawal of the rejections of claims 1, 3, 5, 7-9, 11-12 and 14-15 under 35 U.S.C. §102(e) is respectfully requested.

#### **Rejection of Claims 2 and 10 under 35 U.S.C. §103**

The Examiner has rejected claims 2 and 10 under 35 U.S.C. §103(a) as being unpatentable over Fries. With all respect to the Examiner, that rejection is respectfully traversed.

Claims 2 and 10 depend from allowable independent claim 1, and recite additional features thereof. For at least the same reasons as discussed above, Applicants respectfully submit that Fries also does not teach, suggest or disclose the Applicants invention recited in claims 2 and 10. Therefore, withdrawal of the rejections of claims 2 and 10 under 35 U.S.C. §103(a) is respectfully requested.

#### **Rejection of Claims 4 and 6 under 35 U.S.C. §103**

The Examiner has rejected claims 4 and 6 (and 13, see below) under 35 U.S.C. §103(a) as being unpatentable over Fries in view of the TV Anytime as an application scenario for MPEG-7 article by Pfeiffer and Srinivasan (hereinafter TV Anytime). The Applicants respectfully traverse the rejection.

TV Anytime discloses a proposed use of MPEG-7 metadata content tools as a basis for forming a specific schema of instance documents for use by TV Anytime. That instance document is to be parsed by an application program and then used to perform a search on metadata or to access audio-visual (AV) materials according to the metadata. TV Anytime provides an example wherein a viewer uses a web interface to form a query regarding (AV) soccer highlights, which is then sent to associated service provider software. That software collects the requested information and sends it to a viewer's Personal Digital Recorder (PDR), which is apparently the TV of the future. The PDR then accesses the requested AV material.

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Claims 4 and 6 depend from allowable independent claim 1, and recite additional features thereof. Applicants respectfully submit that Fries does not teach, suggest or disclose the Applicants' invention recited in claim independent claim 1. Furthermore, TV Anytime does nothing to close the gap between Fries and the invention recited in claim independent claim 1. For example, TV Anytime does not disclose storing presentation guide software for presenting an electronic program guide at a user location. Consequently, claim 1 and its dependent claims 4 and 6 are allowable.

Applicants further submit that there is no suggestion or motivation to combine the teachings of Fries and TV Anytime. TV Anytime relates to how MPEG-7 generic descriptions of video and audio material can be used in TV Anytime's framework to find AV data. Fries does not relate to MPEG-7 at all, nor does Fries relate to finding AV data. For prior art references to be combined to render obvious a subsequent invention under 35 U.S.C. §103, there must be something in the prior art as a whole which suggests the desirability, and thus the obviousness, of making the combination. Uniroyal v. Rudkin-Wiley, 5 U.S.P.Q.2d 1434, 1438 (Fed. Cir. 1988). The teachings of the references can be combined only if there is some suggestion or incentive in the prior art to do so. In re Fine, 5 U.S.P.Q.2d 1596, 1599 (Fed. Cir. 1988). Hindsight is strictly forbidden. It is impermissible to use the claims as a framework to pick and choose among individual references to recreate the claimed invention Id. at 1600; W.L. Gore Associates, Inc. v. Garlock, Inc., 220 U.S.P.Q. 303, 312 (Fed. Cir. 1983).

In view of the foregoing, withdrawal of the rejections of claims 4 and 6 under 35 U.S.C. §103(a) is respectfully requested.

#### **Rejection of Claim 13 under 35 U.S.C. §103**

The Examiner has rejected claim 13 under 35 U.S.C. §103(a) as being unpatentable over Fries in view of the TV Anytime as an application scenario for MPEG-7 article by Pfeiffer and Srinivasan (hereinafter TV Anytime). The Applicants respectfully traverse the rejection.

The Examiner asserts that Fries teaches all of the limitations of claims 13 in the rejection of claim 1, meaning that the rejection of claim 1 based on Fries as disclosed also applies to claims 13, except that claim 13 recites parsing the promotional metadata

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to determine one or more valid electronic program guide features that are available. Applicants wish to remind the Examiner that it is the claims as a whole that define the invention, not just individual elements. Claim 13 defines a specific invention comprised of numerous elements that interact to achieve a particular purpose in a particular manner. Claim 13 relates to using broadcast advertisements to carry metadata that is then parsed out by local presentation software and used to form part of an electronic program guide. For convenience, claim 13 is presented below, with particular portions highlighted by underlining:

13.A method for allowing access to interactive features of an electronic program guide by a user from within a broadcast advertisement, the method comprising:

storing presentation guide software for presenting an electronic program guide at a user location;

receiving the broadcast advertisement and promotional metadata over a broadcast distribution network, the promotional metadata comprising information regarding the promotional advertisement and one or more electronic program guide features that may be accessed from within the broadcast advertisement;

parsing the promotional metadata to determine the one or more valid electronic program guide features that are available;

displaying the electronic program guide on a display device;

presenting one or more valid electronic program guide features within the electronic program guide; and  
executing an available electronic program guide feature.

Fries relates to transmitting pages of information having metadata content which can then be accessed by a user. No presentation software forming a program guide that includes material sent by an advertisement. TV Anytime relates to matching an instance document to MPEG-7 format to find AV data. No permissible combination of Fries and TV Anytime teach or suggest using broadcast advertisement to carry metadata for display in an electronic program guide. Nor is there any particular reason to combine the teachings of Fries and TV Anytime.

In view of the foregoing, withdrawal of the rejections of claim 13 under 35 U.S.C. §103(a) is respectfully requested.

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**CONCLUSION**

Thus, Applicants submit that none of the claims presently in the application are indefinite under the provisions of 35 U.S.C. §102, or obvious under the provisions of 35 U.S.C. §103. Consequently, Applicants believe that all these claims are presently in condition for allowance. Accordingly, both reconsideration of this application and its swift passage to issue are earnestly solicited.

If, however, the Examiner believes that there are any unresolved issues requiring adverse final action in any of the claims now pending in the application, it is requested that the Examiner telephone Mr. John M. Kelly Esq. at (732) 530-9404 so that appropriate arrangements can be made for resolving such issues as expeditiously as possible.

Respectfully submitted,

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